

Application No. : 10/760,589
Art Unit : 3611

Attorney Docket No. 23380.01
Confirmation No. 1124

REMARKS

By the present amendment, Applicant has amended Claims 1, 8, 9, 19 and 20, and canceled Claims 7 and 18. In addition, the specification has been amended to furnish the omitted application number of Applicant's parent case. Claims 1-6, 8-17, 19 and 20 remain pending in the present application. Claim 1 is the sole independent claim.

In the recent Office Action the Examiner rejected Claims 1-6, 10 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Chelius (U.S. Patent No. 4,720,123) in view of Crooks et al. (D411,230) and further in view of McCormack (D480,104). Claims 7, 9 and 11-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chelius in view of Crooks et al. and McCormack, and further in view of Stawski II (U.S. Patent No. 5,573,404). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Chelius in view of Crooks et al., McCormack and Stawski, II, and further in view of Selman (U.S. Patent No. 4,852,282). Claims 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chelius in view of Crooks et al. and McCormack, and further in view of Dubner et al. (U.S. Patent No. 5,016,917).

Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

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Independent Claim 1 has been amended to more particularly define the embodiment of Applicant's invention shown in Figs. 5A-5D. Amended Claim 1 sets forth a birthday calendar for recording birthdays and other annual dates that generally includes a backing having disposed thereon a twelve-month chart and a monthly calendar. The backing is characterized as being of a rigid and of unitary construction and defining a first and a second section. The twelve-month chart is characterized as being a single sheet disposed on the first section of the backing, and having vertical and horizontal parallel arranged intersecting lines imprinted thereon defining a plurality of memorandum spaces for recording a date of an annually recurring event. A transparent protective cover is set forth as being removably disposed over the chart. The monthly calendar is set forth as being disposed on the second section of the backing. The claimed birthday calendar is further defined as including a plurality of attachment members for removably attaching the monthly calendar to the backing. An advantageous feature of Applicant's claimed calendar is set forth in the "whereby" clause which recites that "the chart provides a record of annually recurring events selectively recorded thereon by an user and the monthly calendar displays the days of the month, and wherein both the chart and the monthly calendar are simultaneously visible."

Applicant contends that the combination of references relied upon of record by the Examiner is insufficient to render the presently claimed invention obvious within the meaning of 35 U.S.C. 103 since the essential features which form the basis of amended Claim 1 are neither disclosed nor realistically suggested by the applied prior art.

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Applicant first notes that obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987). Further, the Federal Circuit in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999) deprecated rejections based upon "a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The Court said that "the showing must be clear and particular" and that broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis".

As this court has stated, "virtually all [inventions] are combinations of old elements." (*citations omitted*). ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensoronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

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To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. (*Emphasis added*).

In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998) at 1457-58.

The primary reference to Chelius discloses a customized printed calendar comprising a planar sheet having a plurality of surface sections formed by the printing of information thereon. Chelius specifically states that his calendar is prepared by a "computer-driven printer system once name and birthdate information is obtained for a given person." (Col. 1, lines 21-24). Unlike Applicant's calendar, Chelius' calendar is not designed to allow an individual user to enter information subsequent to the creation of the calendar. A user of Applicant's calendar can conveniently enter new event information in the memorandum spaces of the chart at any time during the course of the year. According to Chelius' disclosure, a new calendar would have to be printed to incorporate the new information. Moreover, there appears no description in Chelius of a calendar having a rigid backing, a transparent protective cover and attachment members for removably attaching the monthly calendar to the backing as called for by Applicant's present claims.

In order to supplement the apparent deficiencies of Chelius relative to the presently claimed embodiment of Applicant's invention, the Examiner relies upon the secondary references to Crooks et al., McCormack, Stawski, II, Selman and Dubner. The design patent to Crooks et al. merely depicts a twelve

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month colored calendar sheet displaying twelve separate charts for each of the twelve months, which depiction is structurally and ornamentally unrelated to Applicant's presently claimed calendar. Similarly, McCormack does not show a single twelve month chart with a separately removable monthly calendar. Rather, McCormack shows thirteen individual month calendars distributed in two separate rows and a single monthly calendar disposed between the two rows. Each of the thirteen individual month calendars does not have memorandum spaces. Only the single month disposed in the middle of the calendar has memorandum spaces, whereas Applicant's birthday calendar has memorandum spaces for the twelve month chart.

With regard to the Selman patent, this reference teaches a calendar frame for magnetic attachment to a refrigerator door. The calendar frame receives a calendar sheet and includes a transparent cover. The relevancy of this reference to the presently claimed invention is not apparent. The Stawski, II patent was relied upon by the Examiner for its teaching of a transparent plastic cover over a printable flexible sheet material imprinted with chart information. However, Stawski's cover is not removable since this reference realistically teaches that the sheet material is imprinted with the chart information and thereafter laminated with a plastic. While the Examiner relies upon the Dubner et al. patent for its teaching of a calendar having a rigid backing (20), a realistic reading of this reference reveals that the calendar merely includes a front cover 18 and rear cover 20 bound on a spiral. There appears no disclosure in Dubner et al. of a rigid, unitary backing for a two-section calendar as set forth by the present claims.

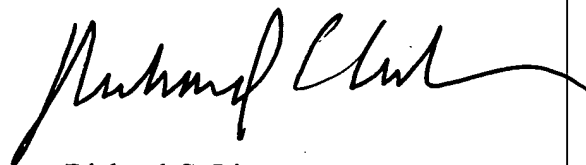
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Applicant contend that one of ordinary skill in the art would not be motivated or guided by the prior art to combine these references in the manner suggested by the Examiner. Applicant further contend that even if these references were properly combinable, one would not be capable of arriving at the presently claimed invention with the benefit of Applicant's own disclosure. For at least these reasons, Applicant respectfully submits that Claim 1, as amended, and dependent claims 2-6, 8-17 and 19 and 20 are allowable over the prior art applied of record.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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